

## REMARKS

This is responsive to the Non-Final Office Action mailed May 23, 2008. At the time of the Office Action, Claims 1-22 were pending. Claims 1-22 stand rejected. Claims 1-22 remain pending.

### **Rejections under 35 U.S.C. §103**

Claims 1-5, 8, 13, 15-17, 19, and 21-22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2005/0089150 A1 (hereinafter “*Birkhead*”) and further in view of U.S. Patent Application Publication No. 2002/0091566 A1 (hereinafter “*Siegel*”).

The basic test for nonobvious subject matter is whether the differences between the subject matter and the prior art are such that the claimed subject matter as a whole would not have been obvious to a person having ordinary skill in the art to which the subject matter pertains. The United States Supreme Court in *Graham v. John Deere & Co.* set forth the factual inquiries which must be considered in applying the statutory test: (1) a determination of the scope and contents of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art. *See Graham*, 383 U.S. 1 (1966).

#### i) Determining Scope and Content of Prior Art

In determining the scope and content of the prior art, the Examiner must first consider the nature of the problem on which the inventor was working. Once this has been established, the Examiner must select, for purposes of comparing and contrasting with the claims at issue, prior art references that are reasonably pertinent to that problem (the inventor's field of endeavor). *See Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 30 U.S.P.Q.2d 1377, 1379 (Fed. Cir. 1994). In selecting references, hindsight must be avoided at all costs.

*Birkhead* relates to a voice-enabled interactive (i.e., automatic) drug and medical information system for converting and transmitting on-line drug and medical information events

in real time. *See* ABSTRACT. The files and documents are processed through speech recognition and text-to-speech systems for converting content, speech, and audio information into generated voice instructions. *See* ABSTRACT. The voice enabled on-line drug and medicine information system permits the user to interact with drug and medical information by means of telephone. *See* paragraph [0015].

*Siegel* relates to a system and method whereby a telephone is used as a consumer request device for issuing promotions to the consumer. *See* paragraph [0002]. The consumer uses a telephone to select appropriate promotions targeted towards products the consumer intends to buy. *See* paragraph [0024]. A host computer provides an advertising medium for new or alternative products by prompting a consumer to alternative products which may have more substantial promotion savings. *See* paragraph [0046]. A host computer connects a consumer on the telephone to a promotional database via an IVR system. *See* paragraph [0053]. The host computer determines if the consumer is a frequent shopper. *See id.* The consumer is interrogated to determine which promotions the consumer requests based on promotion requests information received from the consumer. *See* paragraph [0054].

ii) Differences Between the Prior Art and the Claims at Issue

The second step within the test described in *Graham* is ascertaining the differences between the cited prior art and the claims at issue. A *prima facie* showing of obviousness requires the Examiner to establish that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention. The showings must be clear and particular. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

There are fundamental differences between the cited references and the rejected claims. Further, no combination of the references teaches every limitation of the rejected claims.

Rejected claim 1 recites, "wherein HTU instructions are operating instructions for the service or product associated with the HTU topic corresponding to the HTU dialogue module." The Office Action broadly cites 13 paragraphs in *Birkhead*, Specifically paragraphs [0044]-[0056], as purportedly disclosing these elements. *Birkhead*, taken alone or in combination with

*Siegel*, does not disclose these elements and the Office Action does not establish a *prima facie* case of obviousness. The cited paragraphs describe FIG. 2. It is unclear which of the elements in *Birkhead* the Office Action is relying on as being "operating instructions." Further, it is unclear why the Office Action relies on chemical and medical information for drugs as being "operating instructions." See paragraph [0008]. Applicants respectfully assert that any "operating instructions" for how to use drugs may be provided by a prescribing doctor but not by a telephone-operated information system. FIG. 2 and the relied upon paragraphs disclose providing a caller with a chemical name, a chemical makeup, contraindications, adverse reactions, and side effects. None of these disclosed elements in *Birkhead* are operating instructions that instruct a caller how to use the drug.

As further purportedly disclosing the above limitations regarding operating instructions, the Office Action relies on paragraphs [0044]-[0056] and what is "elsewhere in the art." Further, the Office Action states, "it would be obvious for the medical information topic to be operating instructions related to a medical service or device." Applicants object to the Office Action's unsupported use of what is reportedly "elsewhere in the art" in the rejections of the claims. Further, Applicants object to the unsupported position in the Office Action that "it would be obvious for the medical information topic to be operating instructions related to a medical service or device." The Office Action provides no basis for this conclusory assertion. *Birkhead*, taken alone or in combination with the other references, does not disclose providing operating instructions related to a medical service or device—however, to the extent a drug is a medical device, *Birkhead's* providing the chemical name, chemical makeup, contraindications, adverse reactions, and side effects of the drug does not disclose "operating instructions." To be sure, a telephone service such as *Birkhead's* that provides drug and medical information is not an HTU system as claimed for at least the reason that it does not disclose HTU instructions that are operating instructions for the service or product (i.e., drugs) associated with an HTU topic corresponding to an HTU dialogue module.

Claim 2 has analogous elements to claim 1 including, "wherein HTU instructions are operating instructions for the corresponding services or products." As discussed above with

regard to claim 1, no combination of *Birkhead* and *Siegel* discloses any HTU instructions that are operating instructions for drugs. Therefore, as discussed above, claim 2 is allowable over the cited references. Claims 3-12 and 21-22 depend from claim 2 and are allowable for at least the same reasons.

Claim 13 has analogous elements to claims 1 and 2 including, "Information modules for providing the caller with verbal HTU instructions associated with a selected topic." [emphasis added]. As discussed above with regard to claim 1 and claim 2, no combination of *Birkhead* and *Siegel* discloses any HTU instructions for drugs. The Office Action cites paragraphs [0044]-[0056] and "elsewhere in the art" as allegedly disclosing these elements. Again, Applicants object to the Office Action's unsupported use of anything that is purportedly "elsewhere in the art" and not specifically identified as part of a *prima facie* case of obviousness including motivation to combine what may be "elsewhere in the art" with the teachings of *Birkhead* and the other cited references. The cited portion of *Birkhead* discloses "drug and medical information" (in paragraph [0044]), a drug definition (in paragraph [0045]), a chemical name (in paragraphs [0046] and [0052]), a contraindication prompt (in paragraphs [0047] and [0054]), adverse reactions (in paragraphs [0048] and [0055]), and side effects (in paragraphs [0049] and [0056]). Nowhere does *Birkhead*, taken alone or in combination with the other references, disclose any information modules for providing the caller with verbal HTU instructions associated with a selected topic. For least these reasons, claim 13 and its dependent claims 14-20 are allowable over the cited references.

Claim 1 recites, "in response to the prompting step, recognizing the caller's response such that unsupported services or products are recognized and an appropriate message is played." The Office Action relies on *Birkhead's* paragraphs [0091]-[0093]. The relied upon portions of *Birkhead* do not teach or suggest these elements. Instead, this portion of *Birkhead* discloses that recognition engine 122 searches its input recognition set for a match and if there is an unsuccessful match between the response of the user and the input recognition set, the user is re-prompted or the call may be terminated. See *Birkhead*, paragraph [0093]. The recognition set in *Birkhead* is not disclosed as including unsupported products and services. Indeed, *Birkhead's*

system apparently does not know if a caller has requested information regarding an unsupported drug. *Birkhead's* recognition engine 122 depends on a set of predetermined vocabulary words. See *Birkhead*, paragraph [0028]. *Birkhead* does not disclose playing an appropriate message when unsupported services or products are recognized. Instead, it discloses taking certain actions (e.g., ending a call) if a caller's speech is not recognized. If, as in *Birkhead*, the caller's speech is not recognized as being part of a predetermined vocabulary, then *Birkhead* does not teach or suggest claim 1's limitation that unsupported services or products are recognized and an appropriate message is played.

Claim 1 recites "determining if a response from the caller is to be disambiguated" and "disambiguating the response by determining if the response corresponds to a category having more than one service or product, and if so, providing a list of services or products within that category, prompting the caller for a response, and recognizing the caller's response." The Office Action admits that *Birkhead* does not teach "determining the need for disambiguation and disambiguating the response of category having more than one or more service or product by providing the list of services or products within the category..." However, the Office Action does not point out where *Siegel* discloses these elements. Indeed, *Siegel* does not disclose these elements in the cited portions. Therefore, the cited references, taken alone or in combination, do not recite every limitation of rejected claim 1, and the rejection should be withdrawn.

The Office Action cites paragraphs [0059]-[0061] and FIG. 6 as disclosing elements of claim 1. This portion of *Siegel* discloses a consumer selecting a department in which the consumer wishes to obtain a promotion, a host computer presenting a category list to the consumer, the consumer selecting an appropriate category, and the host computer presenting a product list to the consumer for those products within the department and category in which there are available incentives. See *Siegel* paragraph [0059]. The claimed operation relating to determining if the response from a user needs disambiguation is not disclosed by *Siegel*, taken alone or in combination with *Birkhead*.

iii) Motivation to Combine

In order to establish a *prima facie* case of obviousness, it is necessary for the Office Action to present evidence, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge that one having ordinary skill in the art would have been led to modify or combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301 (Bd. Pat. App. & Int. 1993); *Ashland Oil, Inc. v. Delta Resins and Refractories, Inc.*, 776 F.2d 281 (Fed. Cir. 1985). The motivation or suggestion to modify or combine references must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 47 U.S.P.Q. 2d 1453, 1458 (Fed. Cir. 1998). The showings must be clear and particular. *In re Dembicz*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teachings of multiple references, standing alone, are not evidence. *Id.* In order to establish a *prima facie* case of obviousness, the Office Action must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). Simply relying upon the Examiner's own subjective opinion is insufficient to establish a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002).

The Office Action does not, as required, state sufficient motivation to combine the references. As motivation to combine *Birkhead* and *Siegel*, the Office Action states, it would have been obvious, "to modify Birkhead to provide and ask for the selection of category and to provide the product information based on the category selection by the caller according to hierarchy as taught by Siegel in order to provide the consumer with telephone access to the promotion database through an interactive voice response system and to provide the consumer with promotion choices from a correlated product category associated with a particular group of products in which the consumer is interested in buying." This statement may describe the

operation of *Siegel's* system, but it does not provide motivation to combine *Birkhead* and *Siegel*. The Office Action has not established why a person of ordinary skill in the art having *Birkhead* in hand, would combine *Birkhead* and *Siegel* to achieve the claimed subject matter. What is more, a combination of *Birkhead* and *Siegel* would not function as claimed. A combination would disclose a system that provides a user with drug information (e.g., the drug's chemical name, chemical makeup, contraindications, adverse reactions, and side effects) and allows the user to drill down in a promotion database to learn about incentives regarding the drugs. Nowhere does the combination of references disclose a "how to use" call system as claimed, with HTU instructions that are operating instructions for the service or product associated with the HTU topic, that determines if a response from a caller is to be disambiguated, and that disambiguates the response by determining if the response corresponds to a category having more than one service or product.

For at least the reasons discussed, *Birkhead* and *Siegel*, taken alone or in combination, do not render the subject matter of amended claim 1 obvious. Therefore, claim 1 is allowable over the cited references. Further, as discussed above, claims 2-12 and 21-22 are also allowable. Also as discussed above, claim 13 and its dependent claims 14-20 are allowable over the cited references, taken alone or in combination.

Claims 9 and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Birkhead* and further in view of U.S. Patent Application Publication No. 2001/0014146 A1 (hereinafter "*Beyda*"). As discussed above, claims 2 and 13 are allowable over the cited references, for least the reason that the cited references including *Beyda*, taken in any combination, do not disclose every limitation of claims 2 and 13, and due to their dependencies, do not disclose every limitation of claims 9 and 18.

Claims 10 and 20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Birkhead* and further in view of U.S. Patent Application Publication No. 2002/0055351 A1 (hereinafter "*Elsley*"). As discussed above, claims 2 and 13 are allowable over the cited references, for least the reason that the cited references including *Elsley*, taken in any combination, do not disclose

every limitation of claims 2 and 13, and due to their dependencies, do not disclose every limitation of claims 10 and 20.

Claims 11 and 14 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Birkhead* and further in view of U.S. Patent Application Publication No. 2001/0025309 A1 (hereinafter "*Macleod Beck*"). As discussed above, claims 2 and 13 are allowable over the cited references, for least the reason that the cited references including *Macleod Beck*, taken in any combination, do not disclose every limitation of claims 2 and 13, and due to their dependencies, do not disclose every limitation of claims 11 and 14.



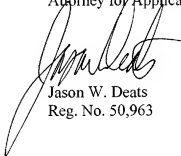
**CONCLUSION**

Applicants believe this response addresses each ground of rejection in the Office Action. Applicants respectfully request reconsideration of the pending claims.

The Commissioner is hereby authorized to charge the \$120.00 one-month extension fee, as well as any other fees necessary, or credit any overpayment, to Deposit Account No. 10-0096 of Jackson Walker L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512-236-2025.

Respectfully submitted,  
JACKSON WALKER L.L.P.  
Attorney for Applicants



Jason W. Deats  
Reg. No. 50,963

SEND CORRESPONDENCE TO:  
JACKSON WALKER L.L.P.  
CUSTOMER ACCOUNT NO. **67942**  
512.236.2025  
512.391.2162 (FAX)